

REMARKS

Claims 124-129 are pending in this application. Claims 1-123 have been canceled without prejudice or disclaimer in the Preliminary Amendment filed January 2, 2004. Claims 125-129 have been withdrawn from consideration in the Office Action mailed June 23, 2006, as not reading on the elected species.

Response to Previous Arguments

Applicants appreciate the Office's acknowledgement that the response filed on September 25, 2006 was sufficient to overcome the rejections made in the Office Action mailed June 23, 2006. Applicants' arguments in response to the newly-applied reference are set forth below.

Information Disclosure Statement (IDS) filed January 2, 2004

A review of the returned and initialed forms PTO-1449 and PTO/SB/08 indicates that several of the references cited in the IDS filed January 2, 2004 were crossed out and/or not initialed. It is presumed therefore that these non-considered references are missing from the file of parent Application Serial No. 09/655,844 and/or other prior applications, relied upon for priority under 35 U.S.C. § 120, in which copies of the references were initially provided. In accordance with 37 C.F.R. 1.98(d), Applicants were not required to submit copies of these references.

Nevertheless, copies of these previously filed references have now been obtained and accompany this response, together with a Request for Consideration of Previously Filed References. Consideration of these references is again respectfully requested, together with a return of the enclosed forms PTO/SB/08a and 08b initialed by the Examiner indicating the same.

The Rejection of Claim 124 under 35 U.S.C. § 102(b)

Claim 124 has been rejected under 35 U.S.C. § 102(b) as anticipated by Barrish *et al.*, J. MED. CHEM. (1994) 37:1758-1768 (“Barrish”). Applicants respectfully traverse this rejection.

Barrish was published in 1994, whereas the present application claims priority under 35 U.S.C. §§ 120 and 121, to U.S. application Serial No. 08/110,913 (now U.S. Patent No. 5,521,219), filed August 24, 1993, as well as to U.S. application Serial No. 07/935,071, filed August 25, 1992, now abandoned. Both of these applications, relied upon for priority, disclose the same subject matter as the present application and therefore also disclose the subject matter of pending claims 124-129 “in the matter provided by the first paragraph of section 112 of this title.” See 35 U.S.C. §§ 120 and 121. Barrish is therefore not valid as a prior art reference against the pending claims.

Reconsideration and withdrawal of the rejection is respectfully requested.

Rejoinder of Claims 125-129 (M.P.E.P. § 821.04)

Claims 125-129, by virtue of their dependency on claim 124, are of the same scope and therefore comply with the requirements under M.P.E.P. § 821.04(a) for rejoinder. Upon a finding that elected claim 124 is allowable, the non-elected claims 125-129 must be rejoined. See M.P.E.P. § 821.04(a).

Applicants therefore respectfully request, upon a finding that elected claim 124 is allowable, rejoinder of non-elected claims 125-129.

CONCLUSION

In view of the above amendments and remarks, pending claims 124-129 of this application are believed to be in condition for allowance. Acknowledgement of the same is respectfully requested.

This response is believed to completely address all of the substantive issues raised in the Office Action dated November 6, 2006.

Respectfully submitted,
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